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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,485	08/10/2001	Mike Anderson	40229.1USU1	5292

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

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DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,485

Applicant(s)

ANDERSON, MIKE

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Request for Continued Examination

1. The request filed on September 16, 2003 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/927,485 is acceptable and a RCE has been established. An action on the RCE follows.

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2. Claims 2 and 3 have been amended for further examination. Claims 1 and 21-53 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7, 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kassab (6,258,200) in view of Langen (5,290,067).

Kassab discloses in Fig. 3-5, a label for applying to a car window comprising: a vinyl transparent information sheet comprising text (Col. 5, line 56, and Col. 9, lines 1-7) that is visible through the window and formed from a material having static-cling properties, wherein the sheet can be removably affixed to a vehicle window; and an opaque base sheet (30) that has static cling properties (Fig. 5-7) permitting the base sheet to be removed and affixed to the vehicle window. Kassab further teaches any indicia can be placed on the label.

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However, Kassab does not disclose: a display of MSRP information, wherein the text is providing vehicle fuel efficiency; text is white in color; text provides information related to country of origin; wherein the text is flexographically or screen printed.

Langen discloses in Fig. 2, a label for displaying MSRP information (Col. 1, lines 50-59) comprising MSRP text (23) on the information sheet, wherein the text is visible through the window and does not impair the vision of a driver of the motor vehicle (due to transparency). Langen further discloses wherein the text provides vehicle fuel efficiency (29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kassab's label with the indicia taught by Langen's label for the purpose of providing vehicle information to a potential vehicle purchaser.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Therefore, the label of Kassab is capable of displaying information indicia related to a country of origin of manufacture.

In regards to **Claims 4, 12 and 13**, Kassab teaches that the label can be made from vinyl, but is silent with respect to the particular type of vinyl. However, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to construct the base and information sheet of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Furthermore, applicant has not noted the particular type of vinyl was critical to the invention.

In regards to **Claim 5** with respect to the color of the indicia, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Therefore, it would have been obvious to have the text in any desirable color.

In regards to **Claims 9 and 10**, the text being flexographically and screen printed does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to print the text by any type of printing process.

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Response to Arguments

4. Applicant's arguments filed on September 16, 2003 have been fully considered but they are not persuasive.

In response to applicant's arguments that there is no suggestion to modify the Langen reference to use something other than adhesive strips, the examiner submits that the Langen reference is now used to show a particular type of indicia and is now modifying Kassab. The Kassab reference is cited to disclose a means for adhering a label more securely by applying static cling adherence properties along the entire label surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kassab's label with any type of indicia as taught by Langen and *In re Gulack* for the purpose of providing information required by an end user.

In regards to applicant's argument that there is functional relationship between the MSRP information and the sheet due to the fact that "the MSRP information must be on the car window, but its contrasting background does not and the transparent sheet allows it to be there safely", the examiner submits that the question is not whether the MSRP information is functionally related to the sheet, the question is whether the indica "related to country of origin of manufacture of parts of the vehicle" is functionally related to the substrate (transparent sheet) to distinguish it from the prior art.

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In regards to **Claims 15 and 20**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Therefore, the label of Kassab is capable of displaying information indicia related to a country of origin of manufacture.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 14, 2003



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